



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,673	08/19/1999	MASAYUKI YAMANA	20-4594P	6781

7590 09/23/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

16

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/355,673

Applicant(s)

YAMANA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 12 and 14-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 14-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. ***Claim 6 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

The recited "a monomer having conjugated double bonds or one or two carbon to carbon double bonds" per claim 6 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "repeating units which are derived from a monomer having a carbon-carbon double bond" especially since the claim does not recite "further comprising".

Claim Rejections - 35 USC § 102

3. ***The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:***

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. ***The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:***

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. ***Claims 2-8, 12 and 14-33 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Misaizu et al as per reasons of record per***

Art Unit: 1713

paper no. 13, 12/12/01, paragraph no. 5. Further, the other copolymerizable monomers taught per col. 5, lines 41-54 include vinyl chloride, vinylidene chloride, glycidyl (meth)acrylates, dimethylaminoethyl (meth)acrylates, etc. and clearly overlap in scope with repeating units (IV) and (V) per claim 2. Misaizu et al anticipate the instantly claimed invention with the understanding that the small genus of "other copolymerizable vinyl monomers" is sufficiently small enough to engender anticipation(In re Schaumann, 572 F.2d 312, 197 USPQ 5, CCPA 1978).

Claim Rejections - 35 USC § 102

6. *Claims 34 and 35 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP'695(Yoshio et al) as per reasons of record per paper no. 13, 12/12/01, paragraph no. 6.*

Response to Arguments

7. *Applicant's arguments filed 06/12/02 have been fully considered but they are not persuasive.*

Relative to the 112, 2nd paragraph issues---While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in the previous office action, at least one issue still remains and is as set forth supra.

Relative to Misaizu et al—Misaizu et al disclose other copolymerizable vinyl monomers that are operable within the scope of his invention and include monomers which meet both repeating units (IV) and (V) per the instant claims(see col. 5, lines 41-54). Further, the composition of Misaizu et al would be expected to possess properties such as high water repellency and oil repellency since the composition of Misaizu et al is essentially the same as and made in essentially the same manner as the claimed composition. In any event, when a claimed composition is not novel, a new property or use cannot impart patentability(In re Spada, 15 USPQ 2d 1655, FED. Cir. 1990). Contrary to Counsel's belief, the Examiner has made a prima facie case of anticipation.

Art Unit: 1713

***Relative to JP'695(Yoshio et al)*—Counsel is cordially directed to page 6 of JP'695 wherein monomers meeting repeating units (II) are taught. Counsel is herein reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in noway limited to the working runs.**

***Relative to the Declaration under 37 CFR 1.132*—A declaration of this nature is insufficient to confer patentability under 35 USC 102(b), i.e., unexpected results are immaterial to a 102 rejection(In re Malagari, 182 USPQ 549, CCPA 1974).**

***Relative to the indication, on the cover sheet(PTO-326)*—It is clear that this was an inadvertent error since claim 12, along with claims 2-8 and 14-33 was rejected in the Office Action(paper no. 13, 12/12/01, paragraph no. 5). No where in the body of the Office Action was claim 12 ever indicated as being allowable. The Examiner apologizes for any inconvenience that this may have caused applicants.**

***Relative to future 112, 2nd paragraph issues*—Additional 112 issues have come to the Examiner's attention. However, since there is a viable rejection being maintained in this case, the 112, 2nd paragraph rejections are not being made at this time but will be made in the future. As a courtesy to applicants, the 112 issues are as follows:**

Claims 23 and 24 engender improper multiple dependency.

In claim 24, "the treatment" engenders the non-establishment of proper antecedent basis.

Claims 28 and 33 are dependent from a cancelled claim, viz., claim 1.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 1713

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
September 20, 2002